UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/747,678	BEN-YOSEPH, ROY
	Examiner	Art Unit	
	Shaq Taha	2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 December 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1 - 39_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1 - 39_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _03/28/2005, 02/23/2007_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

The instant application having Application No. 10/747,678 has a total of 39 claims

pending in the application; there are 3 independent claims and 36 dependent claims, all

of which are ready for examination by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 – 11, 13 – 30, & 32 - 39 are rejected under 35 U.S.C. 102(e) as being

anticipated by Malik et al (US 7,133,898).

- Regarding claim 1, Malik teaches a method of displaying e-mail: **[Fig. 8, Ref # 810];**

  maintaining a list of people associated with a user, **[Prior to presenting the e-mails to the user, the client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract) & (Fig. 4)];**

  receiving one or more e-mails directed to the user, **[E-mail is received at the e-mail server and periodically downloaded upon request from the e-mail client, (Column 1, lines 55 – 60) & (Fig. 8, Ref # 810)];**

  identifying senders of the received e-mail, **[The vendor registration code is a string of characters used to identify e-mail from the particular e-mail source, (Column 6, lines 45 – 50) & (Fig. 6, Ref # 814)];**

  comparing the identified senders to the maintained list of people associated with the user to determine which of the senders are included on the list, **[Fig. 7, Ref # 714, it is determined whether the username and source identify a contact of the particular user];**

  displaying a list of the e-mail to the user, **[Fig. 8, Ref # 810];**

  sorting the displayed list based on which of the senders are included in the list, **[Fig. 8, Ref # 812 & 814].**

- Regarding claim 2, Malik teaches the method wherein sorting the display based on which of the senders are included in the list comprises sorting the display such that e-mails from people on the list are grouped in one position of the display, **[Fig. 8, Ref # 812 & 814].**

- Regarding claim 3, Malik teaches the method wherein sorting the display, based on which of the senders are included in the list comprises sorting the display such that e-mails from people on the list are displayed and e-mails from people not on the list are not displayed, **[Fig. 8, Ref # 812 & 814].**

- Regarding claim 4, Malik teaches the method wherein sorting the display based on which of the senders are included in the list comprises sorting the display such that e-mails from people on the list are not displayed and e-mails from people on the list are not displayed, **[Fig. 8, Ref # 812 & 814].**

- Regarding claim 5, Malik teaches that the method further comprising: inferring that a person is associated with the user based on positive user actions related to e-mail communications from the person, **[if the e-mail is from a source that is identified in a contact list, (Column 9, lines 25 – 30)];**

adding the inferred person to the list, **[storing a vendor registration code for the e-mail source; storing a vendor registration purpose code for the e-mail source, (Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].**

- Regarding claim 6, Malik teaches the method wherein the positive actions include sending an e-mail to the person, **[someone that that the user knows, whether the e-mail is from a commercial vendor that has registered to send e-mail to the user, (Column 1, lines 62 – 67)].**

- Regarding claim 7, Malik teaches the method wherein the positive actions include replying to, forwarding, saving, or printing an e-mail received from the person, **[e-mail users spend significant amounts of time reviewing and replying to the numerous e-mails that they receive daily, (Column 1, lines 30 – 32) & (Column 2, line 2)].**

- Regarding claim 8, Malik teaches the method wherein the positive actions include moving an e-mail from a first folder to a second folder, **[Fig. 8, Ref # 810 & 812].**

- Regarding claim 9, Malik teaches the method wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig. 8, Ref # 810 & 812].**

- Regarding claim 10, Malik teaches the method wherein the positive action includes leaving an e-mail from the person open for a predetermined period of time, **[Fig. 8, Ref # 810, 812, 814].**

- Regarding claim 11, Malik teaches that the method further comprising: inferring that a person is associated with the user based, at least in part, on detecting a communication between the user and the person, **[Prior to presenting the e-mails to the user, the client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract)];** adding the inferred person to the list, **[storing a vendor registration code for the e-mail source; storing a vendor registration purpose code for the e-mail source, (Column 10, lines 6 – 10) & (Fig. 6, Ref # 816)].**

- Regarding claim 13, Malik teaches that the method further comprising inferring that a person is associated with the user, wherein inferring comprises: accessing a contact list of the user to determine a first contact on the user's contact list, **[Fig. 7, Ref # 714];** and accessing a contact list of the first contact to determine a second contact on the first contact's contact list, **[Fig. 7, Ref # 714].**

- Regarding claim 14, Malik teaches that the method further comprising inferring that a person is associated with the user based, at least in part, on detecting user actions that negate an inference that a person is associated with the user, **[Prior to presenting the e-mails to the user, the client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract)].**

- Regarding claim 15, Malik teaches the method wherein the user actions comprise reporting a communication from the person as spam, **[E-mail users must sort through all of the SPAM in order to get to the e-mail that they desire to see, (Column 1, lines 34 – 36)].**

- Regarding claim 16, Malik teaches the method wherein the user actions comprise adding a person to a blacklist, **[Fig. 8, Ref # 814].**

- Regarding claim 17, Malik teaches the method wherein the user actions comprise moving a communication from the person to either of a spam folder or a delete folder, **[Fig. 8, Ref # 812 & 814].**

- Regarding claim 18, Malik teaches that the method further comprising: enabling the user to expressly designate a person as associated with the use **[Fig. 7, Ref # 724 & 732];** and adding the designated person to the list, **[storing vendor registration code for the e-mail source; storing a vendo registration purpose code for the e-mail source, (Column 10, lines 6 – 1 & (Fig. 6, Ref # 816)].**

- Regarding claim 19, Malik teaches the method wherein the people associated with the user are people known to the user, **[The client sorts the e-mail into classifications based upon whether the e-mail is from a personal contact, (Abstract)].**

- Regarding claim 20, Malik teaches a computer-usable medium having a computer program embodied thereon for displaying e-mail, the computer program comprising instructions for causing a computer to perform the following operations: maintain a list of people associated with a user; receive one or more e-mails directed to the user; identify senders of the received e-mail; compare the identified senders to the maintained list of people associated with the user to determine which of the senders are included on the list display a list of the e-mail to the user; and sort the displayed list based on which of the senders are included in the list, **[A computer readable medium having**

computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 1 above)].

- Regarding claim 21, Malik teaches the medium wherein, to sort the display based on which of the senders are included in the list, the computer program further comprises instructions for causing a computer to sort display such that e-mails from people on the list are grouped in one position of the display, [A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 2 above)].

- Regarding claim 22, Malik teaches the medium wherein, to sort the display based on which of the senders are included in the list, the computer program further comprises instructions for causing a computer to sort the display such that e-mails from people on the list are displayed and emails from people not on the list are not displayed, [A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 3 above)].

- Regarding claim 23, Malik teaches the medium wherein, to sorting the display based on which of the senders are included in the list, the computer program further comprises instructions for causing a computer to sort the display such

that e-mails from people on the list are not displayed and e-mails ITom people

on the list are not displayed, **[A computer readable medium having**

computer executable instructions thereon for implementing the method,

(Column 9, lines 23 – 25) & (Same as claim # 4 above)].

- Regarding claim 24, Malik teaches the medium wherein the computer program

  further comprises instructions for causing a computer to: infer that a person is

  associated with the user based on positive user actions related to e-mail

  communications from the person; add the inferred person to the list, **[A**

  computer readable medium having computer executable instructions

  thereon for implementing the method, (Column 9, lines 23 – 25) & (Same

  as claim # 5 above)].

- Regarding claim 25, Malik teaches the medium wherein the positive actions

  include sending an e-mail to the person, **[A computer readable medium**

  having computer executable instructions thereon for implementing the

  method, (Column 9, lines 23 – 25) & (Same as claim # 6 above)].

- Regarding claim 26, Malik teaches the medium wherein the positive actions

  include replying to, forwarding, saving, or printing an e-mail received from the

  person, **[A computer readable medium having computer executable**

instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 7 above)].

- Regarding claim 27, Malik teaches the medium wherein the positive actions include moving an e-mail from a first folder to a second folder, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 8 above)].**

- Regarding claim 28, Malik teaches the medium wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 9 above)].**

- Regarding claim 29, Malik teaches the medium wherein the positive action includes leaving an e-mail from the person open for a predetermined period of time, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 10 above)].**

- Regarding claim 30, Malik teaches the medium wherein the computer program further comprises instructions for causing a computer to: infer that a person is associated with the user based, at least in part, on detecting a communication between the user and the person; add the inferred person to the list, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 11 above)]**.

- Regarding claim 32, Malik teaches the medium wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user and wherein, to infer that a person is associated with the user, the computer program further comprises instructions for causing a computer to: access a contact list of the user to determine a first contact on the user's contact list; and access a contact list of the first contact to determine a second contact on the first contact's contact list, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 13 above)]**.

- Regarding claim 33, Malik teaches the medium wherein the computer program further comprises instructions for causing a computer to infer that a person is

associated with the user based, at least in part, on detecting user actions that negate an inference that a person is associated with the user, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 14 above)]**.

- Regarding claim 34, Malik teaches the medium wherein the user actions comprise reporting a communication from the person as spam, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 15 above)]**.

- Regarding claim 35, Malik teaches the medium wherein the user actions comprise adding a person to a blacklist, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 16 above)]**.

- Regarding claim 36, Malik teaches the medium wherein the user actions comprise moving a communication from the person to either of a spam folder or a delete folder, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 17 above)]**.

- Regarding claim 37, Malik teaches the medium wherein the computer program further comprises instructions for causing a computer to: enable the user to expressly designate a person as associated with the user, and add the designated person to the list, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 18 above)]**.

- Regarding claim 38, Malik teaches the medium wherein the people associated with the user are people known to the user, **[A computer readable medium having computer executable instructions thereon for implementing the method, (Column 9, lines 23 – 25) & (Same as claim # 19 above)]**.

- Regarding claim 39, Malik teaches an apparatus for displaying e-mail: means for maintaining a list of people associated with a user; means for receiving one or more e-mails directed to the user; means for identifying senders of the received e-mail; means for comparing the identified senders to the maintained list of people associated with the user to determine which of the senders are included on the list means for displaying a list of the e-mail to the user; and means for sorting the displayed list based on which of the senders are included in the list, **[Same as claim # 1 above]**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
>
> set forth in section 102 of this title, if the differences between the subject matter sought to be
>
> patented and the prior art are such that the subject matter as a whole would have been obvious
>
> at the time the invention was made to a person having ordinary skill in the art to which said
>
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
>
> was made.

Claims 12 & 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik

et al. (US 7,133,898) as applied to claims 1 above, and further in view of Lewis et al.

(US 2003/0110212).

- Regarding Claims 12 Malik teaches the method according to claim 1, as

  described above. Malik further teaches a system for intelligently sorting e-mail

  comprises a client, which downloads e-mails from a server, **(See Abstract).**

  Malik et al. differs from the claimed invention is that the communications are

  instant messages is not taught in Malik et al.

Lewis teaches a method for providing message information to a subscriber in a wireless network includes reading a cookie from a browser, modifying the cookie with the message information, transmitting the modified cookie to the browser, and displaying data to the subscriber based on the message information contained in the cookie, **(See Abstract),** and further teaches that **[text messages including, for example, short messages, instant messages, and MOBITEX messages, enhanced messages, (Paragraph 0212)].**

Lewis provides the advantage of that the communications are instant messages. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Malik by including that the communications are instant messages as taught by Lewis.

One of ordinary skill in the art would have been motivated to make this modification in order provide the advantage of that the communications are instant messages.

Conclusion

The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **PEP 707.05(c)**.

The following are analogous art because they are from the same field of endeavor of Identifying and using identities deemed to be known to a user:

- Malik et al. Paten No: (7,133,898)

- Lewis et al. US Pub No: (US 20030110212)

- Ingerman et al. US Pub No: (US 2004/0255122)

- Skalecki et al. Patent No: (US 6,195,354)

- Evans et al. US Pub No: (US 2005/0198173 A1)

- Tucciarone et al. US Pub No: (US 2003/0009385 A1)

- Bhatia et al. US Pub No: (US 2005/0160144 A1)

- Bulfer et al. US Pub No: (US 2006/0036701 A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shaq Taha** whose telephone number is 571-270-1921. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Jeff Put** can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

9/6/07

S. Taha

Supervisory Patent Exmr